

REMARKS

Claims 1-4, 6-8, 11-14, 17-23, and 25-31 are pending in this application; claims 1, 6, 17-19, 26, 27, and 31 being independent. In light of the amendments and remarks contained herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 1, 4-6, 8-9, 11-12, 15-21, and 24-27 under 35 U.S.C. § 102(e) as being unpatentable over *Garfinkle et al.* (USP 6,133,985); and rejected claims 2-3, 7, 13-14, and 22-23 under 35 U.S.C. § 103(a) as being unpatentable over *Garfinkle et al.* in view of *Parulski* (EP 0 860 980 A2). Applicants respectfully traverse these rejections.

Claim Rejections - 35 U.S.C. § 102(e)

By this Amendment, Applicants have amended claims 1, 6, 18, and 19 to include the limitations of dependent claims 5, 9, 15, and 24, respectively, and have further amended claims 17, 26, and 27 to more appropriately recite the present invention. Further, Applicants have added new claims 28-31.

In support of the Examiner's rejection of claim 5, the Examiner asserts that, although it is not explicitly stated, it is well known and inherent for an electronic mail system to comprise a user address setting means for enabling the service user to set their electronic mail address thereof. The Examiner further asserts that the mail transmitting means describes the mail address set by the user address setting means as the address of the sender of the electronic mail message.

It is respectfully submitted that *Garfinkle et al.* teaches a method of processing digital images and distributing visual prints produced from the digital images. Specifically, *Garfinkle et al.* teaches at col. 5, lines 25-28:

The interface B allows the photographer 8 to perform specific tasks using the digital images, such as the ability to electronically mail (e-mail) an image to another party;...

In contrast, the present invention as set forth in amended claim 1 recites, *inter alia*, an application server used in a network photograph service system comprising user address setting means for enabling the service user to set their electronic mail address thereof wherein the address of the sender of the electronic mail message is an **automatic reply address**.

In order to find anticipation of a claimed invention under 35 U.S.C. § 102, the cited reference must teach each and every claim element. The Examiner asserts that it is inherent that the system set forth in *Garfinkle et al.* inherently describes the mail address set by the user address setting means as the address of the **sender** of the electronic mail message. It is submitted that, typically, the sender of the mail message is a server. Thus, the mail would be forwarded to the server when replied to in an automatic return operation. However, it is respectfully submitted that *Garfinkle et al.* fails to teach the address of the sender of the electronic mail message being an automatic reply address. It is further submitted that it is not inherent that the address of the sender of the electronic mail message be an automatic reply address. As such, it is respectfully submitted that claim 1 is not anticipated by *Garfinkle et al.* It is further respectfully submitted that claims

dependent upon claim 1 are allowable at least for the reasons set forth above with regard to claim 1 based upon their dependency on claim 1.

It is further respectfully submitted that independent claims 6, 17-19, 26, 27, and 31 contain elements similar to those discussed above with regard to claim 1 and, thus, claims 6, 17-19, 26, 27, and 31, together with claims dependent thereon, are not anticipated by *Garfinkle et al.*

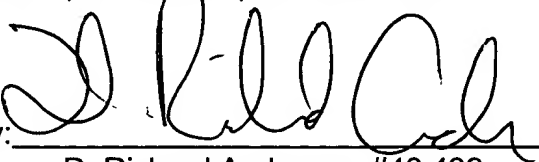
CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisin (Reg. No. 52,327) at the telephone number below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 

D. Richard Anderson, #40,439

DRA/CMV/jdm
2091-0186P

P. O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment: Version With Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 5, 9, 15, 16, and 24 have been cancelled without prejudice or disclaimer of the subject matter contained therein.

The claims have been amended as follows:

1. (Three Times Amended) An application server used in a network photograph service system comprising:

image storing means for storing a plurality of images;

image selecting means for enabling a service user to select at least one of the plurality of stored images, by enabling the stored images to be viewed on the network;

mail generating means for generating an electronic mail message with the selected image as an attachment to the electronic mail message, without requiring a recipient of the electronic mail with attached image to activate an address that points the recipient to a file which stores the selected image;

destination address specifying means for enabling the service user to specify a destination address of the electronic mail message; [and]

mail transmitting means for transmitting the electronic mail message to the destination address specified by the destination address specifying means[.]; and

user address setting means for enabling the service user to set their electronic mail address thereof.

wherein the mail transmitting means describes the mail address set by the user address setting means as the address of the sender of the electronic mail message, and wherein the address of the sender of the electronic mail message is an automatic reply address.

6. (Three Times Amended) An application server used in a network photograph service system, comprising:

image storing means for storing a plurality of images;

image selecting means for enabling a service user to select at least one of the plurality of stored images, by enabling the stored images to be viewed on a network;

mail generating means for generating an electronic mail message with an address of the selected image;

destination address specifying means for enabling the service user to specify a destination address of the electronic mail message;

mail transmitting means for transmitting the electronic mail message to the specified destination address wherein the mail transmitting means describes the mail address set by the user address setting means as the address of the sender of the electronic mail message, and wherein the address of the sender of the electronic mail message is an automatic reply address; and

user address setting means for enabling the service user to set their mail address.

17. (Amended) A network photograph service system, comprising:

image storing means for storing a plurality of images;

image selecting means for enabling a service user to select at least one of the plurality of stored images, by enabling the stored images to be viewed on a network;

mail generating means for generating an electronic mail message with an address of the selected image, wherein a mail address of the application server is set as an address of the sender, and wherein the address of the sender of the electronic mail message is an automatic reply address;

destination address specifying means for enabling the service user to specify a destination address of the electronic mail message; and

mail transmitting means for transmitting the electronic mail message to the specified destination address; and

user address setting means for enabling the service user to set their mail address.

18. (Amended) A method of sending electronic mail messages with attached images in a network photograph service system, comprising:

displaying a plurality of selectable images to be transmitted to a recipient as an attachment to an electronic mail message, for viewing by the user on a device of the user;

selecting at least one of the plurality of selectable images at the user's device;

displaying the selected at least one image in a manner that distinguishes the at least one image from the rest of the selectable images;

reading an image file corresponding to the selected image from a memory;

converting the read image file into an attachment document format for the electronic mail message; [and]

setting the user's send address for sending the electronic mail message with image attachment, said setting performed by the user, wherein said transmitting step transmits the electronic mail message with image attachment using the set send address of the user, and wherein the address of the sender of the electronic mail message is an automatic reply address; and

transmitting the electronic mail message with attached image to the recipient.

19. (Amended) A method of sending electronic mail messages with attached images in a network photograph service system, comprising:

displaying a plurality of selectable images to be transmitted to a recipient as an attachment to an electronic mail message, for viewing by the user on a device of the user;

selecting at least one of the plurality of selectable images at the user's device;

displaying at the same time a comment box, a destination input box, and images having been selected as targets of transmission;

reading an image file corresponding to the selected image from a memory at the server;

converting the read image file into an attachment document format for the electronic mail message; [and]

setting the user's send address for sending the electronic mail message with image attachment, said setting performed by the user, wherein said transmitting step transmits the electronic mail message with image attachment using the set send address of the user, and wherein the address of the sender of an electronic mail message is an automatic reply address; and

transmitting the electronic mail message with attached image to the recipient.

26. (Amended) A method of sending electronic mail messages with attached images in a network photograph service system, comprising:

storing a plurality of images;

enabling a service user to select at least one of the plurality of stored images, by enabling the stored images to be viewed on a network;

displaying the selected at least one image in a manner that distinguishes the at least one image from the rest of the selectable images;

generating an electronic mail message with an address of the selected image;

enabling the service user to specify a destination address of the electronic mail message;

providing the address of a sender of the electronic mail message as an automatic reply address;

transmitting the electronic mail message to the specified destination address;
and

enabling the service user to set their mail address.

27. (Amended) A method of sending electronic mail messages with attached images in a network photograph service system, comprising:

storing a plurality of images;

enabling a service user to select at least one of the plurality of stored images,
by enabling the stored images to be viewed on a network;

displaying at the same time a comment box, a destination input box, and the
at least one image having been selected as targets of transmission;

generating an electronic mail message with an address of the selected
image;

enabling the service user to specify a destination address of the electronic
mail message;

providing the address of a sender of the electronic mail message as an
automatic reply address;

transmitting the electronic mail message to the specified destination address;
and
enabling the service user to set their mail address.

New claims 28-31 have been added.